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10/512,035	10/20/2004	Gotz-Ekkehard Sapper	PAT-01023	2224
26/923	7/590	07/07/2008		
BASF CORPORATION Patent Department 1609 BIDDLE AVENUE MAIN BUILDING WYANDOTTE, MI 48192			EXAMINER RONESL VICKERY M	
			ART UNIT 1796	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Attachment to Advisory Action

Applicant's response filed on 6/19/2008 has been fully considered but is not persuasive.

Specifically, applicant argues (A) that Sapper teaches a grinding resin (explicitly excluded from the claims) because grinding resins are dispersants and not necessarily used in a grinding process; (B) that there is no suggestion in the prior art to use 15 to 25 % by weight of mica; (C) that Sapper does not teach a pigment paste; and (D) that the conductive pigments taught by Bergfried are not equivalent to the mica taught by Sapper.

With respect to argument (A), Sapper teaches an acrylate polymer which is used to adjust viscosity and stabilize coating formulations (col. 1, lines 53-54). The fact that a grinding resin behaves as a pigment dispersant does not exclude all dispersants from the presently claimed composition. If that were the case, the claimed non-ionic surfactant would also be excluded for aiding dispersion of the solids components in the composition. In fact, Sapper does not teach that the acrylate polymer is used as a dispersant for a pigment, rather, it teaches that is used to adjust viscosity and stabilize coating formulations (not just pigments). While such polymers may be used as grinding aids as shown by other references as cited by applicant, such is not explicitly taught by Sapper.

With respect to argument (B), while Sapper discloses an amount of mica pigment in a coating composition less than presently claimed and Bergfried discloses an amount of pigment more than presently claimed, it is considered that the amount of pigment is determined by the desired metallic effect and would have been obvious to one of ordinary skill in the art to utilize a suitable amount of mica in a pigment paste in order to get the desired metallic effect in a final coating comprising the pigment paste. It is the examiner's position that the amount of mica is a

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result effective variables because changing them it clearly affect the type of product obtained.

See MPEP § 2144.05 (B). Case law holds that “discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With respect to argument (C), given that Sapper discloses a composition comprising mica, nonassociative thickener, nonionic surfactant, amine, and water and further given that pigment pastes are known to contain such ingredients before being added to a binder as taught by Bergfried, it would have been obvious to one of ordinary skill in the art to prepare the presently claimed pigment paste before adding to a binder to prepare a coating composition because changing the mixing order is *prima facie* obvious since the end-product is the same.

With respect to argument (D), Bergfried teaches that mica can be used as a supporting pigment for the electrically conductive pigment (page 3, line 31). Therefore, mica of Sapper would be expected to have the same aqueous solution behavior as the conductive pigment taught by Bergfried.

6/29/2008
Vickey Ronesi

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